

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES



In re application of:

David W. NELSON

Appl. No. 10/719,063

Confirmation No. 9139

Filed: November 24, 2003

For: Capturing Device for Insects

Art Unit: 3643

Examiner: Rowan

Atty. Docket No.: 36729-198472

Customer No.:

26694

APPEAL BRIEF
Third Corrected Version

Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

(i) REAL PARTY IN INTEREST. The applicant, David W. Nelson, an individual, is the real party in interest for this appeal.

(ii) RELATED APPEALS AND INTERFERENCES. There are no pending related appeals or interferences. The applicant previously appealed related claims in a previous application which are now incorporated in U.S. Patent No. 6,651,379.

(iii) STATUS OF CLAIMS. Claims 1-20 are pending in this application. Claims 1-20 are the subject of this appeal.

(iv) STATUS OF AMENDMENTS. A Response to the final Office Action was filed July 25, 2005 with amendments to claims 3 and 4. The Amendment was not entered by the Examiner.

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(v) ***SUMMARY OF CLAIMED SUBJECT MATTER.***

Claims 1 and 19 are independent claims. Support for the claim can be found at Fig 15 and the related discussion in the specification at page 8 lines through page 9 lines 11; page 10 lines 6-8; and page 11 lines 1-3 and lines 17-20.

Claim 1- The invention recited in claim 1 relates to a device for capturing insects or other small pests. Referring to Fig 15, the device enables a user to easily catch or restrain insects without having to physically touch or handle the insects directly and provides a convenient disposal. The invention recited in claim 1 is best understood by reference to Fig. 15, showing the adhesive layer 136 displaced upon the top side of a compressible material 138 of a sheet. The bottom side 142 or bottom surface may be engaged by the user. In this embodiment the adhesive 136 is disposed on the engaging surface of the sheet. The material 138 will collapse in response to the engagement with an insect thereby embed the insect in the substrate. In preferred embodiments the substrate can absorb liquid residue from an insect.

Claim 13 is dependent on claim 1 and requires the adhesive to be dispersed over the substrate in a discontinuous manner.

Claim 14 is dependent on claim 13 and directed to an alternative embodiment of the invention wherein the adhesive is located in wells (950) that are displaced from the leading edge (921) extension area (907) of the substrate (900). This embodiment is depicted in Figs. 18 and 19. When an insect is engaged by the leading edge (921) of this embodiment of the device, the substrate (900) is compressed and will collapse so that the adhesive in the wells (950) will come

into contact and engage the pest. In this embodiment, the top surface of the device can gently engage a surface and the adhesive will not come into contact with the surface. Only after pressure is applied will the surface, or a pest that has alighted on the surface come into contact with the adhesive.

Claims 15 is directed to a device where the adhesive is in a striped pattern and Claim 16 is directed to a circular pattern. Support for this limitation can be found at *inter alia* Figs. 12, 13 and Fig 16 and 18.

Claim 17 is directed to the hydrophilic quality of the device recited in Claim 1. Support for this feature is found at page 7, line 8 et seq; at page, 8 lines 8-9., page 9, lines 3-4, and page 9 line 20 through page 10 line 1; page 14 line 3-8.

Claims 19 and 20 are directed to a method of use of the device recited in claim 14. Claim 19 is an independent claim. Support for the claim can be found at Fig 15 and the related discussion in the specification at page 8 lines through page 9 lines 11 and page 10 lines 6-8; and page 11 lines 1-3 and lines 17-20.

(vi) GROUND OF REJECTION TO BE REVIEWED

The following issues are presented to the Board:

Whether claims 1, 4, 9 11, 12 and 18 are properly rejected under 35 U.S.C. §102 in view of the patent to Hughes, U.S. Patent No. 2,962,836 (“Hughes”)

Whether claims 1-3, and 12 are properly rejected under 35 U.S.C. §102 in view of “Post It” Brand notes.

Whether claims 2-3, 5-6, 7-8 10, 17 are properly rejected under §103 as being unpatentable over the patent to Hughes.

Whether claims 13, 14, 15 and 16 are properly rejected under §103 over Hughes in further view of view of European Patent Application 0 367 539 to Sherman (hereinafter “EP ‘539” (Sherman)”).

Whether claims 19 and 20 are properly rejected over Hughes, in view of the EP ‘539 (Sherman) and in further view of Shuster.

(vii) ARGUMENT INCLUDING GROUPING OF CLAIMS

The claims are grouped as follows:

Group I - Claims 1-3, 5-12, 18;

Group II - Claim 4;

Group III - Claim 13

Group IV - Claims 14, 15, 16;

Group V - Claim 17;

Group VI - Claims 19-20

It is respectfully submitted that the above groups of claims are separately patentable and do not stand or fall together. The reason for this is that, while the arguments applicable to Group I are also applicable to Groups II-VI, there are additional arguments in favor of the patentability of each of Groups II-VI.

Argument

Introduction: This application is a continuation-in-part of an earlier Application No. 09/625,357 that issued as U.S. Patent No. 6,651,379 which was a continuation of Application No. 09/246,543 now U.S. Patent No. 6,185,862 issued February 13, 2001 and U.S. Application No. 08/832,384, now abandoned.

The '357 application that issued as '379 Patent was also the subject of an appeal to this Board and a copy of the decision on appeal is attached hereto and included in the related Proceedings Appendix. It is submitted that some of the issues presented in the present appeal are similar to those that were previously litigated, and to the extent that the Board's previous findings may have preclusive or persuasive effect, the decision is cited herein. In this regard, in the appealed case the Examiner applied the same references at issue in this appeal and some of the important limitations of the claims at issue are similar.

For example Claim 1 on appeal is similar to Claim 1 of the '379 Patent which issued from the '357 application discussed above. (Notable exceptions are that the new claim does not have the claimed feature wherein opposite sides of the device are devoid of adhesive and that the hydrophilic limitation has been recited in dependent claim 17.)

Group I - Claims 1-3, 5-12, 18.

Claim 1 stands rejected under Section 102 in view of the patent to Hughes, U.S. No. 2,962,836 (the "Hughes patent"). The Hughes patent is directed to a pest capturing device or glue trap for capturing mice, rats and other rodents. Hughes is comprised of a hood portion 11 and a plurality of adhesive covered sheets 13 that are positioned on a foundation sheet of

substantially heavy paper 12. In operation, a mouse enters the hood portion 11 attracted by bait 23 on a hanger 24 located under the top wall 19 of the hood. The mouse is trapped by the adhesive on the sheet 13. Hood 11 can be removed and the uppermost sheet can be removed to wrap and remove the mouse from the trap for disposal. The removal of the uppermost sheet of adhesive creates a fresh adhesive surface for the next mouse.

A fundamental disagreement between the applicant and the Examiner is whether the Hughes patent teaches a “*planar sheet substrate*” that, when “*force is manually applied . . . [an] insect will cause the substrate to collapse and form a concave depression which conforms to the shape of the insect and therefore partially embed the said insect within said substrate.*” The Examiner argues that folding the Hughes substrate to envelope the rodent meets this limitation. The applicant respectfully disagrees.

It is submitted that folding a substrate around the pest is not the same as causing the substrate itself to collapse. Further, in the Hughes patent the rodent is not *embedded within the substrate* as the claim requires. Rather, the adhesive sheet merely encapsulates or surrounds the rodent. There is no teaching or disclosure that the rodent actually displaces the surface of the sheet so that it is embedded *into* the sheet substrate. Rather, the sheet is merely wrapped around the rodent.

The Hughes patent fails to teach a *compressible* material that has been coated with an adhesive that functions as claimed. There is nothing in the reference that teaches or suggests that the Hughes substrate may be compressed. While the Examiner has argued that all materials may

be compressed to some degree or another, it is submitted that even if one were to follow the Examiner's reasoning, there is no teaching that pressure from the rear surface in engagement with an insect will compress the substrate that is disclosed so that the substrate will *collapse* and an insect will be embedded therein as the claims require. (Likewise, the Examiner has argued that the plastic material disclosed by EP '539 (Sherman) may be compressed. Once again, even assuming plastic can be compressed, there is no teaching that the plastic material can *collapse* as required by the claims to embed an insect within the substrate.)

Rather, the sheet of the Hughes reference may serve to primarily compress and squash the insect in response to such force. It is submitted that allowing a substrate to collapse in response to engagement with an insect is not an inherent feature of a sheet (presumably of paper) and there is no teaching in the reference that this quality or characteristic is implicit in the structure that is disclosed by Hughes. Accordingly, it is submitted that the Examiner fails to establish a *prima facie* case that claim 1 is anticipated.

The Examiner has also rejected claim 1 in view of "Post It" brand notes. It is submitted for the same reasons set forth above that the Examiner has not demonstrated that this material will collapse around an insect and allow the insect to embed with the surface of the device. There is no disclosure or teaching of this claimed function and this characteristic is not an inherent feature of such note paper. On information and belief, note paper is highly compressed during its manufacture and, as a result, has no ability to collapse in response to engagement with an insect. The Examiner's argument with respect to wrapping up the insect in a "Post It" brand

note is fallacious for the reasons set forth above.

It is further submitted that the Examiner's present argument is analogous to a previous argument advanced by the Examiner that was considered by the Board and not ultimately adopted. In this regard, the Shuster reference disclosed the use of masking tape that covered a sponge-like backing material. In the appeal the Board rejected the Examiner's argument that the masking tape and pad combination anticipated a claim that included a similar limitation requiring that "the substrate will collapse and form a concave depression closely conforming to the shape of the insect and partially embedding the insect..." because the compressible material was not part of the substrate that carried the adhesive but was a separate element. See Exhibit 1. It is submitted that in the previous decision the Board also implicitly found that masking tape by itself was not a compressible material that met this limitation. It is submitted that masking tape, which is structurally similar to "Post It" brand notes and the "adhesive sheet" disclosed by Hughes are not compressible and do not disclose the function as recited in claim 1 that requires the substrate to collapse and allow an insect to embed within the substrate.

Claims 2, 3, 5-12 and 18, which are dependent on claim 1, are also patentable for the reasons that Claim 1 is patentable.

Group II: Claim 4 describes an invention that is separately patentable.

Claim 4 incorporates the limitations of claim 1 and further requires that the structure recited in claim 1 have a rigid backing. Claim 4 stands rejected under Section 102 in view of the

Hughes patent. It is submitted that the combination of providing both the compressible and pliable sheet substrate with a rigid backing provides advantages to the present invention because it improves over a flimsy device – one that is not self supporting – because it allows for improved control when manipulated by hand. The Examiner argues that the Hughes disclosure wherein the stack of sheets is placed on “substantially heavy cardboard” anticipates the claim. The applicant recognizes the combination of Hughes’ “heavy cardboard” and the last adhesive sheet is close to what is recited in claim 1. However, Claim 1 is distinguishable under Section 102 of the Patent Statute because the “substrate” of the invention is one part or one piece and the combination that is advanced by the Examiner necessarily has multiple severable parts. As a result, if one attempted to manually manipulate the Hughes device, the sheet containing adhesive would become disassociated from the cardboard backing if the device was inverted. (While the applicant attempted to further distinguish this structure in an amendment after final, the Examiner did not permit this amendment and argued that it raised a new issue which would require “additional consideration.”)

In any event, it is submitted that claim 1 is distinguishable because it requires a “substrate” and the combination of a rigid backing and the sheet of Hughes does not accurately define a “substrate” as claimed. A substrate is a substratum which is “a material on which another material is coated or fabricated.” See Webster’s II New College Dictionary, copyright 1995. See Evidence Appendix. In the present invention the “coating” is the adhesive. It is significant that the definition is directed to a single “material” on which the coating is applied,

not a combination of materials, or stack of materials. Since the claimed coating (the adhesive) is not applied to the rigid cardboard – either directly or indirectly -- but rather is applied to the compressible substrate -- as the claims require, the combination of the cardboard and sheet material disclosed by Hughes cannot be a “substrate” as required by the claims. Rather, the heavy cardboard backing is a separate and independent layer or structure and not part of the substrate.

Claim 4 is also patentable for the reasons that claim 1 is patentable.

Group III: Claim 13 describes an invention that is separately patentable.

Claim 13 is directed to a device wherein the adhesive is dispersed over the substrate in a discontinuous manner. The Examiner has rejected claim 13 in view of Hughes and EP ‘539 (Sherman). In rejecting the claim the Examiner argues that the function of the discontinuous application of the viscous material of EP ‘539 (Sherman) is the same as that in the invention and no stated problem is solved by the inventor. The applicant respectfully disagrees with the Examiner.

First, it is submitted that there is no suggestion or motivation from any of the prior art of record to alter Hughes with the teachings of EP ‘539 (Sherman) to reach the claimed invention. To the contrary, this arrangement or combination would be counterintuitive because it would result in a device that may be less effective at trapping or capturing the pest as is the stated objective of Hughes. The inventor’s motivation for using a discontinuous surface is explained in

the specification -- to provide a surface that may enhance the hydrophilic characteristics of the substrate of the device and thereby may have increased absorptive properties. As discussed in the specification, this arrangement enhances the function wherein any liquid that may escape from the body cavity of the insect may be easily absorbed. Hughes does not disclose or discuss the problem with leakage of bodily fluids by insects or other pests. Hughes, which discloses trapping rodents and large insects with glue, does not disclose or consider the problem with rupturing the pest during the entrapment or disposal step and therefore provides no incentive to adjust the adhesive pattern to increase the hydrophilic area of the substrate. Another basis for this arrangement is to provide the adhesive in recessed areas wherein it will not be as accessible when the substrate is handled.

While EP '539 (Sherman) discloses a structure that on superficial analysis looks similar to the claimed structure, upon inspection of the structure disclosed by EP '539 (Sherman) and its function, one will reach the conclusion that it is significantly different from the applicant's invention. First, the EP '539 (Sherman) device does not use an adhesive nor does it trap insects on the surface of the device. Rather it attracts flying insects which then may ingest a poison which is provided in the form of viscous material situated in a series of depressions or wells formed by bosses. Further, the reason that the bosses are provided is to interrupt or slow the progress of the flow of the viscous material so that the device can be mounted in a vertical orientation. While the Examiner has contended that viscous material is essentially synonymous with adhesive, the applicant does not agree with this assessment. Viscous materials do not

necessarily or inherently have adhesive properties or tackiness. For example, motor oil and lubricating oil are typically measured in terms of their viscosity. Oils are viscous materials and, it is submitted, such oils do not function as adhesives.

In summary, as explained above, the function of the EP '539 (Sherman) reference is materially different from the function of the applicant's invention and therefore the predicate of the Examiner's argument is incorrect. Secondly, EP '539 (Sherman) does not disclose any adhesive and therefore does not disclose a discontinuous application of adhesive across the substrate. And third, the applicant specifically disclosed the problem of releasing fluids from squashed insects at pages 3, 8 and 9-10 and explained that the discontinuous dispersal of adhesive can improve the absorptive properties of the device.

In any event, there is no motivation to alter the Hughes reference so that the adhesive is dispersed in a discontinuous fashion because one would not be motivated to mount Hughes trap in a vertical direction. Moreover, even if one were to combine the references, the resulting structure would not have the compressible and pliable characteristics as claimed. The structure that separates the poison wells of the EP '539 (Sherman) patent is described as a plastic sheet and there is no disclosure that its structure would be compressible in response to pressure from the behind the substrate to cause the substrate to collapse and embed an insect within the substrate surface.

The rejection of claim 13 is improper and should be withdrawn.

Group IV: Claim 14, 15, 16 describe inventions that are separately patentable.

Claim 14 is directed to an embodiment wherein the adhesive coated engagement area is recessed from the leading edge of the substrate. The Examiner has rejected claim 14 in view of Hughes and EP '539 (Sherman).

First, as discussed above, there is absolutely no reason or motivation to combine EP '539 (Sherman) and Hughes. Second, even if one were to combine these references, the resultant structure is not the same as that recited in claim 14. Neither embodiment of the EP '539 (Sherman) disclosure is directed to substrate material that may be deformed and compressed wherein such pressure allows an engagement area containing adhesive to become closer to the planar surface of the device. As explained in the specification, this function allows a user to engage an insect wherein at first the substrate is caused to come into contact with the insect, and upon application of further pressure from the reverse side of the substrate, the engagement area containing the adhesive may subsequently then engage and restrain the insect. This embodiment has the advantage of not sticking to surfaces on which an insect has alighted unless sufficient force is exerted to compress and collapse the substrate to an extent that the recessed adhesive is exposed and available at the surface of the planar sheet. It is also easier to manipulate because one can touch the surface without contacting adhesive substance.

Because the rejections of claims 14 should be withdrawn, claims 15 and 16 should also be allowed.

Group V: Claim 17 is a separately patentable invention.

Claim 17 is dependent on claim 1 but further requires the substrate to be hydrophilic.

Claim 17 has been rejected by the Examiner in view of Hughes. It is submitted that the hydrophilic limitation or other teaching is completely absent from the Hughes reference. In the Hughes device, the substrate has glue dispersed thereon which is not disclosed to be hydrophilic. The Examiner concedes that there is no disclosure to make the substrate hydrophilic but argues that such a modification is obvious. See paragraph 8 of the rejection. It is submitted that the Examiner's rejection is improper because it is a merely conclusory argument and does not provide the applicant a meaningful way to respond to the rejection. The Examiner cites no combination of references to reach this structure but summarily argues that it would be obvious to make the substrate hydrophilic so that the liquids from the insects will be absorbed if they are crushed. Hughes does not teach crushing an insect or pest and apparently never appreciated the problem because the device merely traps the insect or pest and does not teach the application of pressure against the target to restrain the pest. It is submitted that in order to advance an obviousness rejection, at minimum the Examiner must show that the problem was appreciated by those skilled in the art. Moreover, one would not be motivated to use a hydrophilic substrate in combination with Hughes because his device uses a continuous film of adhesive across the surface. There is no advantage to using an absorbent substrate because the adhesive would serve as a barrier between the absorbent substrate material and the pest. Further, since Hughes is a

passive trap that does not involve rupturing the body cavity of the pest, there would be no reason to modify Hughes to use a hydrophilic substrate.

It is further submitted that the Examiner's argument that people use paper towels to trap insects or clean up residue from insects is inapposite. The applicant has not claimed a paper towel and the claimed invention improves over this device. In addition, the Examiner has not provided the motivation or manner in which to combine a conventional paper towel with the references of record to reach the claimed invention.

Group VI: Claims 19 and 20 are separately patentable.

The Examiner rejected claims 19 and 20 pursuant to 35 U.S.C. Section 103 in view of Hughes, EP '539 (Sherman) and Shuster (U.S. Patent No. 4,052,811). Claim 19 is a method claim using the device recited in claim 14. It is self-evident that none of these references discloses using a restraining device that has the adhesive surface recessed below an absorbent and compressible substrate and allow the pest to deform the compressible materials causing said insect to form a concave depression in the top side of the substrate. Further, it is submitted that there is no motivation to combine the references of record and, in the event that the combination was made, the claimed invention would not be the result.

The Federal Circuit has stated: "there is no basis for concluding that an invention would have been obvious solely because it is a combination of elements that were known in the art at the time of the invention." *See Fromsen v. Advantie Offset Plate, Inc.* 225 USPQ 26, 31 (Fed. Cir. 1985). Instead, the relevant inquiry is whether there is a reason, suggestion, or motivation in

the prior art that would lead one of ordinary skill in the art to combine the references, and that would also suggest a reasonable likelihood of success. *See, e.g., In re Dow Chem. Co.* 5 USPQ2d 1529, 1531-32 (Fed. Cir. 1988.) Applicant does not appreciate or understand the Examiner's argument that EP '539 (Sherman) and Hughes are properly combined. The applicant demonstrated that the functions of the two devices were materially different. In response, the Examiner suggests that one would be motivated to combine the two references so that pests that are not trapped can be killed by poison. While this may be a broad objective, the manner in which the two prior art devices operate are not amenable to combination in such a way that the applicant's invention is reached nor rendered obvious. Further, if this is the goal, it would follow that the combination would include a poison feature. Yet, the applicant does not use poison in his device. Further, if one wanted to merely use the poison feature so that insects that were not trapped would be killed, one would simply add poison to the bait provided by Hughes.

Likewise, it is submitted that Shuster is not properly combined with the Hughes and EP '539 (Sherman) references. While each of these references generally relate to pest control, each of the devices functions in materially different ways and the combinations do not result in the invention that the applicant has claimed.

As discussed above, the Board previously considered a similar claim (a claim without the hydrophilic limitation and wherein the method involved a device that involved an adhesive layer on the leading or top surface) in view of Shuster and Hughes. Like in the previous situation, the prior art does not teach compressing the substrate material, collapsing the substrate or embedding

the insect within the substrate. It is submitted that the existence of the EP '539 (Sherman) reference in this rejection does not alter the rationale because its relevance to the invention, as discussed above, is marginal.

Further, Shuster specifically recognized some of the same problems addressed by the inventor and advanced a different solution. In this regard, both the applicant and Shuster recognize the problem of compressing the insect on a hard surface. As observed by both the applicant and Shuster, crushing the insect can release fluids to the surface and can create a stain or mess on the surface on which the insect is engaged. While Shuster the uses a film over flexible tape that is displaced over a compressible surface, the invention combines some of these feature and omits others. Actually, Shuster teaches away from the applicant's invention because Shuster teaches to remove the tape and then, to subsequently use the sponge-like material to clean the surface. Not only is the chances of crushing the insect reduced by combining the sponge-like surface with the adhesive surface as the applicant teaches, the substrate can also be used to absorb the fluids in the event the body cavity is ruptured without further manipulation. In any event, there is no motivation to combine the specific teachings of Shuster with the specific teachings of Hughes or to modify the teachings of Shuster in the manner proposed by the Examiner.

Conclusion of Argument

For the foregoing reasons, it is respectfully submitted that each of the pending claims are patentable over the cited references. Accordingly, the Examiner's rejection of these claims

should be reversed.

Should the remittance be missing or should any additional fees be required, the Commissioner may charge the appropriate amount to our Deposit Account No. 22-0261 and notify the undersigned accordingly.

(viii) *Claims Appendix.* An appendix is attached containing a copy of the claims involved in the appeal.

(ix) *Evidence Appendix.* The Applicant has cited Webster's dictionary in its argument. To the extent that this citation is considered evidence, a copy of the relevant pages are at includes in the Evidence Appendix.

(x) *Related proceedings Appendix.* Attached in the Related Proceedings Appendix is a Decision by the Board in connection with a parent case of the present application which is relevant to the present issues on appeal.

Respectfully submitted,

Date: *December 1, 2006*



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CLAIMS APPENDIX

1. A device for restraining an insect comprising a planar sheet substrate having a top side and a bottom side, said substrate having an adhesive displaced on said top side to form an engagement area of said top side, said substrate further comprising a compressible, and pliable material, whereby when said sheet is manually manipulated so that when said engagement area on said top side covers an insect and a force is manually applied to said substrate from said bottom side, said insect will cause said substrate to collapse and form a concave depression which conforms to the shape of said insect and therefore partially embed said insect within said substrate.

2. The device as recited in claim 1 wherein said adhesive has adhesive properties substantially similar to the adhesive used on conventional household cellophane transparent tapes.

3. The device as recited in claim 1 wherein said adhesive is a releasable adhesive used on paper note products.

4. The device as recited in claim 1 wherein said substrate further comprises a rigid support means substantially similar to a conventional cardboard index card.

5. The device as recited in claim 1 further comprising removable means covering said engagement area.

6. The device as recited in claim 5 wherein said removable means comprises a non-stick coating provided on said bottom side of a second substrate.

7. The sheet as recited in claim 1 wherein said sheet is provided in the shape of a polygon and having a lateral dimension of less than five inches wide wherein said sheet can be

easily manipulated with a person's hand.

8. The sheet as recited in claim 1 wherein said sheet is provided in the shape of a circle, oval or ellipse.

9. The device as recited in claim 1 wherein said substrate comprises of paper.

10. The device as recited in claim 1 wherein said substrate comprises synthetic resin.

11. The device as recited in claim 1 wherein said substrate has a corrugated configuration.

12. A pad made up of a plurality of sheets as described in claim 1.

13. The device as recited in claim 1 wherein said adhesive is dispersed over said engagement areas in a discontinuous manner and wherein portions of said substrate are exposed on said top surface in said engagement area.

14. The device as recited in claim 13 wherein the device is in the shape of a flat planar sheet and said engagement layer is the second area of contact as the flat planar sheet is brought into contact with a parallel flat planar surface wherein said engagement area is recessed with respect to said compressible material.

15. The device as recited in claim 14 wherein said adhesive is provided in a striped pattern.

16. The device as recited in claim 15 wherein said adhesive is dispersed over said engagement area in a series of circular regions.

17. The device as recited in claim 1 wherein said substrate is hydrophillic.

18. The device as recited in claim 1 further comprising elongate extension means.

19. A method of capturing an insect or pest which is found on a surface comprising application of the top side of the substrate as described in claim 14 to an insect or pest, applying pressure to the rear of said substrate and thereby allowing said non-adhesive surface to be displaced and to allow said adhesive to contact said insect and to restrain said pest, and providing additional pressure from said bottom side of said substrate thereby allowing said compressible material to be further compressed by said insect or pest and causing said insect to form a concave depression in said top side of said substrate.

20. The method as described in claim 19 further comprising folding said substrate so that opposite sides of said adhesive are allowed to contact and engage one another.

Applicant David W. Nelson
Appl. No. 10/719,063

EVIDENCE APPENDIX

See Attached pages from Webster's II New College Dictionary, copyright 1995.

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Library of Congress Cataloging-in-Publication Data

Webster's II new college dictionary.
p. cm.

ISBN 0-395-70869-9 (alk. paper)
1. English language -- Dictionaries. I. Webster's II new
Riverside University dictionary
PE1628.W55164 1995
423 -- dc20

95-5833
CIP

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sub-stan-ti-val (sŭb'stən-ti'vəl) *adj.* Of, relating to, or of the nature of a grammatical substantival. — *sub-stan-ti-val-ly adv.*

sub-stan-tive (sŭb'stən-tiv) *adj.* [ME *substantif* < OFr. < LLat. *substantivus* < Lat. *substantia*, substance.] 1. SUBSTANTIAL 5. 2. Independent in function or existence: not subordinate. 3. Not imaginary: ACTUAL. 4. Of or relating to the essence or substance: ESSENTIAL <substantive data> 5. Having a solid basis: FIRM. 6. Expressing or denoting existence; e.g., the verb to be. 7. Denoting a noun or noun equivalent. — *n.* A word or group of words functioning as a noun. — *sub-stan-tive-ly adv.* — *sub-stan-tive-ness n.*

sub-sta-tion (sŭb'stə'shən) *n.* A subsidiary or branch station, as of a power plant.

sub-sti-tu-ent (sŭb'stit-ŭt'ənt) *n.* [Lat. *substituens*, *substituent*, *pr.* part. of *substituere*, to substitute.] An atom, radical, or group substituted for another in a compound. — *adj.* — *sub-stit'u-ent adj.*

sub-sti-tute (sŭb'sti-tŭt', -tŭt'ŭt') *n.* (< Lat. *substitutus*, *pr.* part. of *substituere*, to substitute: *sub-*, in place of + *statuere*, to cause to stand.) 1. One that takes the place of another: FILL-IN. 2. A word or construction used in place of another word or construction. — *v.* — *tut-ed, tut-ing, -tutes.* — *vt.* To put or use in place of another. — *vi.* To take the place of another <Only art can substitute for nature> — Leonard Bernstein — *sub-sti-tut'a-bil'it-y n.* — *sub-sti-tut'a-bile adj.* — *sub-sti-tut'ion (-tŭt'ŭshən, -tŭt'ŭt'ŭn) n.*

* *SYN:* SUBSTITUTE, ALTERNATE, FILL-IN, PINCH HITTER, REPLACEMENT, STAND-IN, SUB, SUBROGATE *n.* *core meaning:* one that takes the place of another <I hired a substitute for the sick teacher>

sub-sti-tu-tive (sŭb'sti-tŭt'iv, -tŭt'ŭ-) *adj.* Serving or capable of serving as a substitute.

sub-strate (sŭb'strā't) *n.* (< SUBSTRATUM.) 1. The material or substance on which an enzyme acts. 2. Biol. A surface on which a plant or animal grows or is attached. 3. A substratum.

sub-stra-tum (sŭb'strā'təm, -strā'təm) *n., pl. -stra-ta (-strā'tə, -strā'tə) or -stra-tums.* [Med. Lat. < Lat. *stratus*, *pr.* part. of *struere*, to lay under: *sub-*, under + *struere*, to spread out.] 1. *a.* An underlying layer. *b.* A layer of earth beneath the surface soil: SUBSOIL. 2. The foundation: groundwork. 3. The material upon which another material is coated or fabricated. 4. Philos. The characterless substance that supports attributes of reality. 5. Biol. A substrate. — *sub-strā'tive adj.*

sub-struc-tion (sŭb'strŭk'shən) *n.* [Lat. *substructio* < *substruere*, to build beneath: *sub-*, beneath + *struere*, to build.] A foundation: substructure. — *sub-struc-tion-al adj.*

sub-struc-ture (sŭb'strŭk'chər) *n.* 1. A supporting structural part: FOUNDATION. 2. The earth bank or bed supporting railroad tracks. — *sub-struc-tur-al adj.*

sub-sume (sŭb'sŭm') *vt.* — *sūmed, -sum-ing, -sumes.* [Med. Lat. *subsumere*: Lat. *sub-*, from below + Lat. *sumere*, to take up.] 1. To include within a broader class, group, category, or order. 2. To show (e.g., an idea) to be covered by a broad principle or rule. — *sub-sūm'a-bile adj.*

sub-sump-tion (sŭb'sŭmp'shən) *n.* [Med. Lat. *subsumptio*, a subsuming < *subsumere*, to subsume.] 1. *a.* An act or instance of subsuming. *b.* Something subsumed. 2. Logic. The minor premise of a syllogism. — *sub-sūmp-tive adj.*

sub-tem-per-ate (sŭb'tēm'pə-It, -tēm'prIt) *adj.* Of, relating to, or occurring within the colder regions of the Temperate Zones.

sub-tem-per-ant (sŭb'tēm'ənt) *n.* One that rents property, as land or a house, from a tenant. — *sub'tem'an-cy n.*

sub-tend (sŭb'tēnd') *vt.* — *tēnd-ed, -tēnd-ing, -tēnds.* [Lat. *subtendere*, to extend underneath: *sub-*, beneath + *tendere*, to extend.] 1. Math. To be opposite to and delimit <The side of a triangle subtends the opposite angle> 2. To underlie so as to enclose or surround <flowers subtended by leafy bracts>

sub-ter-fuge (sŭb'tər'fjŭj) *n.* [Fr. < LLat. *subterfugium* < Lat. *subterfugere*, to escape: *subter*, secretly + *fugere*, to flee.] 1. A deceptive stratagem or device. 2. Deception by artifice so as to conceal, evade, or escape.

sub-ter-ra-ne-an (sŭb'tə-rā'nē-ən) *adj.* [Lat. *subterraneus*: *sub-*, under + *terra*, earth.] 1. Situated or operating beneath the earth's surface: UNDERGROUND. 2. Hidden: secret <subterranean plots> — *sub'ter-ra-nē-an-ly adv.*

sub-ter-res-trial (sŭb'tə-rēs'trē-əl) *adj.* SUBTERRANEAN 1. — *n.* An animal living underground.

sub-text (sŭb'tēkst') *n.* 1. The implicit meaning or theme of a literary text. 2. The underlying personality of a dramatic character as implied by a script or text and interpreted by an actor in performance. — *sub-text-u-al (-tēks'chŭo-əl) adj.*

sub-tile (sŭt'Il, sŭb'tl) *adj.* — *til-er, -til-est.* Subtle. — *sub'tile-ly adv.* — *sub'til'it-y (-tēks't'Il-tē), sub'til'ty n.*

sub-ti-lin (sŭb'tl-in) *n.* [NLat. *subtilis*, specific epithet of *Bacillus subtilis* + *-IN*.] An antibiotic obtained from the bacterium *Bacillus subtilis* that is active against Gram-positive microorganisms.

sub-ti-lize (sŭt'Il-iz, sŭb'tl-iz') *v.* — *ized, -iz-ing, -izes.* [Med. Lat. *subtilizare* < Lat. *subtilis*, subtle.] — *vt.* To render subtle. — *vi.* To argue or discuss with subtlety. — *sub'til-iz-a'tion n.*

sub-ti-tle (sŭb'tIt'Il) *n.* 1. A secondary, usu. explanatory title, as of a literary work. 2. *a.* A printed translation of the dialogue of a foreign-

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ī tie īr pier ō pot ō toe ō past ō about, i

Applicant David W. Nelson
Appl. No. 10/719,063

RELATED PROCEEDINGS APPENDIX

See attached Decision by the Board in Application No. 09/625,357 that issued as U.S. Patent No. 6,651,379.

The opinion in support of the decision being entered today was not written
for publication and is not binding precedent of the Board.

Paper No. 17

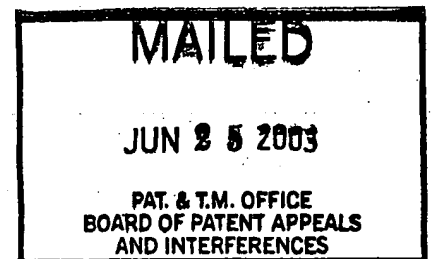
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DAVID W. NELSON

Appeal No. 2002-2275
Application No. 09/652,357

ON BRIEF



Before COHEN, ABRAMS, and BAHR, Administrative Patent Judges.
ABRAMS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-19
and 22, which are all of the claims pending in this application.

We REVERSE.

BACKGROUND

The appellant's invention relates to a device for capturing and restraining a pest such as an insect and to a method for capturing an insect with the device. An understanding of the invention can be derived from a reading of exemplary claim 1, which has been reproduced below.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

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|---------------------------------|-----------|---------------|
| Hughes | 2,962,836 | Dec. 6, 1960 |
| Shuster <u>et al.</u> (Shuster) | 4,052,811 | Oct. 11, 1977 |

Claims 1-19 and 22 stand rejected under 35 U.S.C. § 103 as being unpatentable over Shuster in view of Hughes.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejection, we make reference to the Answer (Paper No. 13) and the final rejection (Paper No. 7) for the examiner's complete reasoning in support of the rejection, and to the Brief (Paper No. 11) and Reply Brief (Paper No. 14) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

The appellant's invention relates to a device for capturing insects or other small pests without having to handle them directly, by manually capturing the pest by attachment to a pressure responsive adhesive on a substrate which can be folded over on itself. Claim 1 sets forth the invention in the following manner:

1. A device for restraining an insect comprising a continuous planar sheet substrate said substrate comprised of a homogeneous material and having a top side and a bottom side, said substrate having an adhesive distributed on said top side to form an engagement area, said engagement area not encompassing two lateral side areas on said top side of said substrate, said top side of said substrate and said engagement area further comprising a compressible, and hydrophilic pliable material, whereby when said sheet is manually manipulated so that when said engagement area on said top side covers said insect and a force is manually applied to said substrate from said bottom side, said insect will cause said substrate to collapse and form a concave depression which closely conforms to the shape of said insect and therefore partially embed said insect within said substrate wherein the body of said insect may displace said substrate without rupturing the body of said insect and said engagement thereby increases the total contact area between said adhesive and said insect, and removable means to cover said adhesive area prior to use.

The examiner has rejected this claim on the basis that the subject matter recited therein would have been obvious¹ to one of ordinary skill in the art in view of Shuster and Hughes. While the examiner has not made specific findings regarding the disclosure of Shuster as compared to the subject matter recited in claim 1, it would appear that the examiner believes Shuster discloses all except for the removable means to cover the adhesive prior to use. However, the examiner expresses the view that to add this feature to the Shuster device would have been obvious in view of the teachings of Hughes. See Paper No. 7, pages 3 and 4. Absent from the examiner's explanation of the rejection is an expression of the suggestion which would have motivated one of ordinary skill in the art to make the proposed modification to Shultz.

We find ourselves in agreement with the appellant that the rejection is fatally defective and cannot be sustained. Our reasoning follows.

Shuster is directed to a device for capturing insects crawling on inaccessible surfaces such as walls and ceilings. It comprises a handle 14 upon the top of which a rigid body 12 is fastened. Body 12 carries a roll of adhesive material 30 such as

¹The test for obviousness is what the combined teachings of the prior art would have suggested to one of ordinary skill in the art. See, for example, In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981). In establishing a prima facie case of obviousness, it is incumbent upon the examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. See Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the appellant's disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir.), cert. denied, 488 U.S. 825 (1988).

masking tape (column 2, line 6) on a spool 44 and a sponge-like triangular support pad 28 over which the tape is extended with its free end being held by an anchoring element 31. In use, the tacky side of the tape is pressed against the insect, which is "immobilized without being crushed because of the resilient backing provided by the pad" (column 2, lines 56-58). The used portion of the tape is then removed and a new section pulled into place over the support pad. See column 2, line 53 et seq.

With respect to the recitation set forth in the appellant's claim 1, it is our opinion that Shuster fails to disclose or teach that the substrate which has an adhesive on its top side further comprises the compressible and hydrophilic pliable material described in the claim, that is, a substrate of such construction that when force is applied to an insect captured by the adhesive, the substrate will collapse and form a concave depression closely conforming to the shape of the insect and partially embedding the insect to increase the total contact area between the adhesive and the insect. In the Shuster device, the compressible material is not part of the substrate that carries the adhesive, but is a separate element. In addition, while Shuster describes the sponge-like pad as "constituting a resilient support to avoid squashing of the insect on the wall or ceiling surface," (column 1, lines 36-38), there is no teaching that the "flexible adhesive tape such as commercial masking tape," even when supported by the sponge-like element, possesses such characteristics as to perform in the manner

prescribed by claim 1 when the device is pressed against an insect on a surface.

Finally, even if it is conceded that masking tape is hydrophilic, this aspect of the terms of claim 1 is not met by Shuster, for the claim requires that both the compressibility and the hydrophilic properties be in the substrate.

Thus, contrary to position taken by the examiner, Shuster fails to disclose or teach that the substrate comprises both the adhesive and the compressible and hydrophilic material. This deficiency is not cured by Hughes, even considering, arguendo, that Hughes teaches providing removable means to cover the adhesive area prior to use, and that suggestion exists which would have motivated one of ordinary skill in the art to utilize such a feature in the Shuster device.

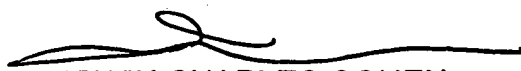
It therefore is our conclusion that the combined teachings of Shuster and Hughes fail to establish a prima facie case of obviousness with regard to the subject matter recited in claim 1, and we will not sustain the rejection. Since all of the remaining claims are dependent from claim 1, it follows that the rejection of those claims also will not be sustained.

CONCLUSION

The rejection of claims 1-19 and 22 is not sustained.

The decision of the examiner is reversed.

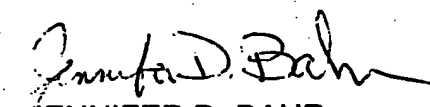
REVERSED



IRWIN CHARLES COHEN
Administrative Patent Judge



NEAL E. ABRAMS
Administrative Patent Judge



JENNIFER D. BAHR
Administrative Patent Judge

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Appeal No. 2002-2275
Application No. 09/652,357

Page 8

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